



PATENT
Attorney Docket No.: 47004.000062

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/688,694 Confirmation No.: 2049
Applicant : Christopher R. Lefebvre *et al*
Filed : October 17, 2000
Title : Method and System for Retaining Customer Loyalty
TC/Art Unit : 3622
Examiner: : Khanh H Le

Docket No. : 47004.000062
Customer No. : **21967**

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below. This application was filed October 17, 2000. The claims were rejected under 35 U.S.C. § 103 by U.S. Patent No. 6,009,415 to Shurling in Office Actions mailed June 4, 2003 and December 1, 2003. The Shurling rejections were withdrawn and a Final Office Action mailed April 30, 2004 rejected the claims over a new reference, U.S. Patent No. 6,611,811 to Deaton. An Appeal Brief was filed July 30, 2004 in response to the 103 rejections over Deaton. The Deaton rejections were withdrawn and a new office action was mailed September 1, 2004 rejecting all the claims over another 103 rejection, this time the Examiner applied U.S. Patent No. 6,061,660 to

Eggleston. That rejection was withdrawn in favor of yet another rejection mailed December 10, 2004 applying U.S. Patent No. 5,644,723 to Deaton. In response to minor amendments to the claims, a final rejection was mailed July 14, 2005 applying the current combination of U.S. Patent No. 6,055,513 to Katz and U.S. Patent No. 6,616,128 to Smyk.

To date, Applicants have submitted five (5) responses to Office Actions, including one Appeal Brief. As a result of Applicants' submissions, all previous rejections have been withdrawn, without substantive amendments to the claims. As the record reflects, the Office has found Applicants' arguments persuasive in response to the all various prior art applied. Applicants find it particularly distressing that each of the later-withdrawn rejections failed to properly address each and every claim limitation, and failed to provide a proper statement of motivation. In sum, a *prima facie* case of obviousness has yet to be set forth for any of the office actions in this application, including the present Office Action dated July 14, 2005. Accordingly, rather than proceeding with another expensive appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

On the merits, claims 19, 21-29, and 31-38 have been rejected under 35 U.S.C. §103(a) as being unpatentable over to Katz in view of to Smyk. That rejection is flawed for at least the following reasons.

The Office Action fails to address each and every claim limitation. As the Examiner admits, Katz fails to show "receiving a request from a customer." ... "wherein the request is a request to terminate relationship with the provider." In addition, the Office Action fails to even

address the claim limitation directed to “retrieving account data ... in response to the request where the account data is displayed on a graphical user interface.” There is further no mention of “identifying the request as a request type...;” “identifying the customer as a customer segment ...;” “identifying one or more incentives based on the *request type* ..., the *customer segment* and one or more *profitability factors*.” Therefore, the Office Action has improperly ignored claim limitations and thus completely failed to set forth a *prima facie* case of obviousness.

Although the Office Action acknowledges that Katz fails to show “wherein the request is a request to terminate a relationship with the provider,” it alleges that such a disclosure is provided by Smyk. In alleging that it would have been obvious to modify Katz in view of Smyk, however, the Office Action states that it would be obvious to do so to “allow upsell in case of cancellation contacts as well so to obviously retain the customer.” The Office Action fails to identify where in Smyk that such a teaching is made. Further, the Office Action never addresses the additional limitations associated with receiving a request to terminate a relationship with the provider and thus, has failed to provide a *prima facie* case of obviousness.


The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action’s sole justification for modifying Katz has

absolutely nothing to do with the deficiencies of Katz. To properly modify Katz to correct for these deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Katz. Any such motivation is completely lacking. Therefore, this is a clear example of improper hindsight. The Office has the burden to show a suggestion or motivation found somewhere in the prior art regarding the desirability of the modification of Katz. See M.P.E.P § 2143.01; see also *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicant when the grounds are so clearly improper. Additionally, where there have already been 5 poorly-constructed and ultimately withdrawn prior rejections, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,



Yisun Song
Registration No. 44,487
for Stephen T. Schreiner
Registration No. 43,097

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
(202) 955-1500
Date: October 13, 2005